

REMARKS

I. Introduction

Applicant gratefully acknowledges the granting of his Request for Continued Examination filed on November 6, 2003. Because Applicant's last submission resulted in the issuance of the present Office Action, he now requests reconsideration in view of the foregoing amendments and the reasons that follow.

II. Status of the Claims and Summary of Amendments Thereto

By way of the foregoing amendments, dependent claims 2, 6, 10, and 14 are cancelled. Thus, claims 1, 3-5, 7-9, 11-13, 15, and 16 are pending. Accordingly, the independent claims are amended to incorporate the subject matter of the cancelled claims, and are amended further to recite a 0.5% (w/w) concentration of an ammonium salt. Support for the latter amendment can be found in the specification at page 3, line 1. Finally, on the Examiner's kind suggestion, claims 9 and 13 are amended to correct a typographical error so that the claims correctly recite an "oil pipeline" in step "b."

III. The Office Action

Applicant gratefully acknowledges the Examiner's withdrawing all previous rejections in light of the response and declaration filed on November 6, 2003 (see Office Action at page 8). The present action propounds new rejections, now discussed in the order presented.

B. Rejection of Claims Under 35 U.S.C. § 112, Second Paragraph

Claims 9-13 are allegedly indefinite because claims 9 and 13 are deemed to lack antecedent basis for the phrase "dry gas pipeline" (Office Action at page 2). The Examiner requested Applicant to clarify this phrase, in the meantime acting on the belief that the phrase originated as a typographical error.

In response, Applicant affirms the Examiner's belief and submits that present claims 9 and 13 no longer are subject to the stated ground for rejection. Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection.

C. Rejection of Claims Under 35 U.S.C. § 112, First Paragraph

1. Ground for Rejection

Claims 1-16 stand rejected for allegedly lacking enablement (Office Action at pages 2-4). Drawing upon Applicant's Declaration, dated November 6, 2003, the Examiner first urges that a discrepancy exists between the claims, which do not recite TRIS, and the Declaration, which places both TRIS and TRIS oxide in the context of the claimed method. Indeed, the Examiner characterizes the Declaration as presenting subject matter that "contradicts to the specification" in this regard. Office Action at page 3.

Secondly, the Examiner alleges that the claims are not enabled because "[i]t appears that at least some additional conditions and/or reagents are required" to address the pH range in which the claimed method operates. Office Action at page 4. In this regard, the Examiner relies upon certain passages in WO 02/08127 ("Fidoe") and previously cited WO 00/21892 ("Odell"), which document the stability of tetrakis(hydroxymethyl) phosphonium salts in the presence of ammonium salts as a function of pH, specifically at values below pH ~3. According to the Examiner, the claims read on pH ranges that are not enabled, i.e., where Fidoe and Odell would foretell decomposition of such salts. To the extent that this rejection may apply to the claims as amended, Applicant respectfully traverses.

2. The Claims Are Enabled Notwithstanding No Mention of "TRIS"

The claims circumscribe a method by which a composition containing three components -- water, tetrakis(hydroxymethyl) phosphonium sulfate or chloride, and a soluble ammonium salt -- complexes iron sulfide when introduced into a dry gas or oil pipeline. At pages 2 and 3, the specification clearly demonstrates that such a composition gives rise to iron sulfide complexation, in the context of the weight-percentage concentrations recited in the claims.

Accordingly, there is no question that the specification enables the present claims. In particular, the skilled person certainly could carry out the method as presently claimed without a detailed understanding, from the specification or elsewhere, of how TRIS is

evolved when the recited composition is used in manner described. By the same token, the fact that the Declaration illuminates the underlying chemistry in no way evidences a need for undue experimentation to implement the claimed invention.

3. Claims Without a pH Recitation Are Enabled

Notwithstanding the Examiner's stated concerns, there is nothing of record to indicate that the skilled person would have any difficulty in using a composition as recited to effect sulfide complexation. That is, a person of skill in the art, even when sensitized to the pH effects documented by Fidoe and Odell, would have no difficulty in practicing the claimed invention, as documented in the above-discussed example. Applicant therefore respectfully submits that the claims are fully enabled and that this rejection should be withdrawn.

D. Double Patenting

Claims 1-16 stand provisionally rejected over claims 1, 2, 7, 9, 10, 17, and 22 of co-pending application serial No. 10/218,905. Specifically, the Examiner alleges that the claims of the '905 application "in combination disclose the limitations of the pending claims." Office Action at page 5.

Respectfully, Applicant defers a response to this rejection, if it is still applicable, until such time as allowable subject matter is indicated. In this regard, Applicant understands that, if the foregoing amendments and remarks obviate the section 112 rejections, then the provisional double patenting rejection will be withdrawn. MPEP § 804(I)(B).

IV. Conclusion

Applicant believes that the present application is in condition for allowance, and he seeks notice to that effect. If the Examiner believes that a telephone interview would advance the prosecution of the present application, he is invited to contact the undersigned by telephone.

Respectfully submitted,

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.